

AMENDMENT &amp; RESPONSE

Serial Number: 09/630,000

Filing Date: August 1, 2000

Title: LEAD HAVING VARYING STIFFNESS AND METHOD OF MANUFACTURING THEREOF

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*Affirmation of Election*

As provisionally elected, without traverse, by Applicant's representative, Catherine I. Klima-Silberg, on April 25, 2002, Applicant elects to prosecute the invention of Group II, claims 16-26.

*§112 Rejection of the Claims*

Claims 16-26 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 16 in accordance with the suggestion in the Office Action; "where" was changed to "wherein." Applicant has further clarified the language with respect to the conductor in claims 16, and 24 - 26. Applicant respectfully traverses the assertion that "claim 1 is incomplete for omitting essential structure cooperative relations of elements," and that "the claim is only a listing of elements and does not disclose the structure relationships or connections between the elements." Page 5, Office Action. Applicant respectfully submits the cooperative relationships are defined in the claim. Clarification or removal of the rejection is respectfully solicited.

*§102 Rejection of the Claims*

Claims 16-20 and 23-26 were rejected under 35 USC § 102(b) as being anticipated by Van Venrooij (U.S. Patent No. 5,849,032). Applicant respectfully submits that all of the elements of the claims cannot be found in the cited reference. For instance, Applicant cannot find in Van Venrooij coradial conductors disposed within the lead body, where the coradial conductors include at least a first conductor formed of a first material having a different stiffness than a second material of a second conductor, as recited in claim 16, from which claims 17 - 20 and claims 23 - 26 depend. Reconsideration and allowance are respectfully requested.

Claims 16-20 and 23 and 26 were rejected under 35 USC § 102(e) as being anticipated by Carner (U.S. Patent No. 6,253,111). Applicant respectfully submits that all of the elements of the claims cannot be found in the cited reference. For instance, Applicant cannot find in Van

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Carner coradial conductors disposed within the lead body, where the coradial conductors include at least a first conductor formed of a first material having a different stiffness than a second material of a second conductor, as recited in claim 16, from which claims 17 - 20, 23 and 26 depend. Reconsideration and allowance are respectfully requested.

§103 Rejection of the Claims

Claims 21 and 22 were rejected under 35 USC § 103(a) as being unpatentable over Van Venrooij (U.S. Patent No. 5,849,032). Claims 21 and 22 depend from claim 16, and include all of the limitations of patentable claim 16. Applicant incorporates the above-discussion of claim 20 herein.

According to the Office Action "it would have been an obvious matter of design choice . . . because applicant has not disclosed that using MP35N and Pt/Ta for the first and second materials provides an advantage, is used for a particular purpose, or solves a state problem." Page 7, Office Action. The Office Action further states that "it would have been an obvious matter of design choice to modify Carner [sic] to obtain the invention" since one of ordinary skill in the art "would have expected applicant's invention to perform equally well with Van Venrooij." Page 7, Office Action. Applicant respectfully traverses these assertions.

Applicant is unaware of a requirement that an Applicant has the burden to demonstrate criticality or unexpected results. "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." MPEP 706.02(j). It is the Examiner who has the burden under 35 U.S.C. §§ 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order for such a conclusion to be reached, either 1) an objective teaching in the prior art suggests that the combination of the elements may lead to the advantageous result, or 2) it is well-known in the art that such a combination would lead to the result. *Id.* The court in *Fine* stated that obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). However, it "cannot be established by combining the teachings of the prior art to

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produce the claimed invention, absent some teaching or suggestion supporting the combination." (emphasis added). *ACS Hosp. Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984). Combination of the teachings of references can only occur if there is some suggestion or incentive to do so. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Reconsideration and allowance of claims 21 and 22 are respectfully requested.

Claim 24 was rejected under 35 USC § 103(a) as being unpatentable over Carner (U.S. Patent No. 6,253,111) in view of Kruse et al., (U.S. Patent No. 5,995,876). Claim 24 depends from claim 16, and include all of the limitations of patentable claim 16. Applicant incorporates the above-discussion of claim 16 herein.

Furthermore, Applicant respectfully traverses the rejection since no motivation to combine the references has been provided. Instead, the Office Action merely concludes that such a modification to Carner would have been obvious, without providing objective evidence as to why. Reconsideration and allowance are respectfully requested.

Claim 25 was rejected under 35 USC § 103(a) as being unpatentable over Carner (U.S. Patent No. 6,253,111) in view of Fischer, Sr. (U.S. Patent No. 6,083,216). Claim 25 depends from claim 16, and includes all of the limitations of patentable claim 16. Applicant incorporates the above-discussion of claim 16 herein.

Furthermore, Applicant respectfully traverses the rejection, and further submits that no legally sufficient motivation to combine the references has been provided. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some *objective* teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. . . . The same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability

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of the modification. *In re Fitch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (emphasis in the original, internal citations omitted).

Reconsideration and allowance are respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612 359-3276) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

BRUCE TOCKMAN ET AL.

By their Representatives,

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Date Aug. 14, 2002

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 14 day of August, 2002.

Name

GREG HANSON

Signature

[Signature]